

REMARKS

With this Response, claim 40 is amended to correct an informality. Claims 35 and 68 is amended. Applicants respectfully request that claim 71 be canceled without prejudice.

Therefore, claims 32-70 are pending.

Claim Rejections – 35 U.S.C. § 102

Claims 65-67 and 71

Claims 65-67 and 71 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,442,390 issued to Hooper et al. (*Hooper*). Claim 71 is canceled herein; therefore, rejection of this claim is moot. Applicants respectfully submit that the cited reference fails to anticipate the invention as recited in the remaining claims for at least the following reasons.

Claim 65 recites the following:

a memory to store digital content;
circuitry, coupled to the memory, to maintain **multiple content counters**,
wherein the content counters **indicate a current location of consumption** for
corresponding digital content.

The Office Action asserts that the read and write pointers of *Hooper* disclose the content counters as claimed. Applicants traverse this assertion. *Hooper* discusses a single read pointer (col. 2, line 12: "**the** read pointer") to indicate memory locations in a memory buffer where playback of a video data commences. *Hooper* also discusses a write pointer to indicate where in the memory buffer received video data should be written. Thus, even if the single read pointer indicates a location of consumption, the write pointer **does not** indicate a current location of consumption; rather, it indicates a location of storage of data. Thus, *Hooper* fails to disclose or suggest multiple content counters to indicate a current location of consumption, as recited in the claim. Therefore, the reference fails to disclose at least this element of the claims, and so fails to

support a prima facie case of anticipation under MPEP § 2131, which requires every element of the claimed invention be shown in a single reference.

Claims 66-67 depend from claim 65, and thus necessarily include the limitations of claim 65. Because the reference fails to disclose every element of the independent claim from which these claims depend, Applicants respectfully submit that the reference fails to anticipate the dependent claims for at least the reasons above.

Claims 32, 34, and 71

Claims 32, 34, and 71 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,855,725 issued to Fernandez (*Fernandez*). Claim 71 was canceled herein; therefore, rejection of this claim is moot. Applicants respectfully submit that the cited reference fails to anticipate the remaining claims for at least the following reasons.

Claim 32 recites the following:

storing a **most-recent episode of a series of digital content published at a first time** in a playback device, wherein the episode is no greater than a predetermined playback time;
automatically selecting a subsequent episode of the series of the digital content published at a second time, wherein the subsequent episode is no greater than a predetermined playback time; and
storing the subsequent episode in the playback device.

Applicants note that the Office Action at page 3 fails to address certain limitations of claim 32. For example, the Office Action fails to point to any part of *Fernandez* purported to disclose or suggest the element of a most recent episode of a series of digital content. Claim 34 depends from claim 32, and thus includes every limitation of claim 32. Because the rejection of claim 32 is incomplete, Applicants submit that the rejection of claim 34 is necessarily incomplete also. Applicants are unable to respond to an incomplete rejection. Applicants therefore respectfully

request that either the rejection be withdrawn, or that a prima facie case of anticipation under MPEP § 2131 be presented.

Claims 68-69

Claims 68-69 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,855,725 issued to Fernandez (*Fernandez*). Applicants respectfully submit that the cited reference fails to anticipate the claims for at least the following reasons.

Claim 68 as amended recites the following:

storing digital content including portions of multiple content files for subsequent playback;

designating portions of memory in a playback device for storage of data of a particular content file;

storing at least a subset of the portions of multiple content files in the playback device, wherein data from a first content file is stored in a first portion of memory and data from a second content file is stored a second portion of memory; and

storing data from the second content file in the first portion of memory designated for storage of data of the first content file when data from the first content file stored in the first portion of memory is consumed.

Fernandez fails to disclose or suggest that portions of a memory in a playback device are designated for storage of first particular content file, and storing data of a second content file in the memory portion designated for the first content file when data from the first content file is consumed. Therefore, Applicants respectfully submit that the reference fails to disclose or suggest at least this limitation of the claim, and therefore fails to anticipate the claim. Claim 69 depend from claim 68, and therefore include every limitation of claim 68. Therefore, Applicants respectfully submit that the reference fails to provide support for an anticipation rejection of this claim for at least the reasons set forth for the independent claim.

Claim Rejections – 35 U.S.C. § 103

Claims 33, 40-64, and 70

Claims 33, 40-64, and 70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fernandez*. Applicants respectfully submit that the cited reference fails to render obvious the claimed invention for at least the following reasons.

Claim 33

Applicants note that claim 33 depends from independent claim 32, discussed above. The Office Action at page 5 states that claim 33 is rejected "under similar rationale as for claim 40." Applicants note that claim 32, from which claim 33 depends, recites different limitations from claim 40. Because claim 33 depends from claim 32, claim 33 includes every limitation of claim 32. Just as with claim 32 above, the Office Action fails to present a prima facie case of anticipation under MPEP § 2131, at least because the Office Action fails to address at least one element of the claim in the rejection. The Office Action fails to specify what parts of the cited reference are purported to disclose or suggest the elements of the claim. Applicants are unable to respond to an incomplete rejection.

Claims 40-64 and 70

Claim 40 as amended recites the following:

retrieving multiple titles of digital media content from one or more libraries;
storing the multiple titles of media content for subsequent playback; and
storing a subset of one or more of the multiple titles of media content in a playback device, wherein the subsets of the multiple titles of media content are automatically selected to update consumed media content **according to a user's predetermined specifications**.

Claims 46, 52, and 70 recite similar limitations directed to a user's predetermined specifications.

Claim 57 includes a limitation directed to predetermined user content selections.

The Office Action at page 4 admits that Fernandez fails to specifically disclose replacing consumed media according to a user's predetermined specifications. The Office Action cites Fernandez at col. 7, lines 54 to 62, which recites:

The choice is more a matter of practical implementation and would depend on whether there is a perceptible delay in transmitting data via the IR link and loading the RAM 46. This in turn is dependent on the baud rates at which the data can be transmitted and the speed of the microprocessor 43 and RAM 46. The choice is, therefore, one of design and will vary from one implementation to another.

The Office Action at pages 4 to 5 asserts that based on this passage, it would have been obvious to provide a user determined specification "because it would have enabled the user to customize the behavior of the system to meet his preference." Applicants respectfully submit that the reference provides no support for the assertion in the Office Action.

Applicants first note that the cited portion of Fernandez is specifically discussing a number of pages before the last page to initiate a transmission to obtain more data. See col. 7, lines 51 to 54: "Consider, for example, a transmission which is initiated, say, five pages before the last page or even every page after a certain number of pages have been displayed." Thus, "the choice" contemplated at col. 7, lines 54 to 62 is a choice of **how many pages before the last page** a transmission should be initiated. Instructively, the "choice" discussed in col. 7, lines 54 to 62 is "a matter of practical implementation," and **not** one of user customization. Thus, Applicants have understood that *Fernandez's* choice "would depend on whether there is a perceptible delay in transmitting data" and "baud rates," and that is why the design "will vary from one implementation to another," and not because a user preference is considered. In short, *Fernandez* fails to disclose or suggest that a user customization is possible, much suggest that there would be some motivation to provide for user customization. Therefore, the reference fails to provide support for the assertion and corresponding rejection in the Office Action.

Thus, Applicants submit that *Fernandez* fails to support a prima facie case of obviousness under MPEP §2143 at least for failing to disclose every element of the claims; therefore claims 40, 46, 52, 57, and 70 are nonobvious over the cited reference. Claims 41-45 depend from claim 40, claims 47-51 depend from claim 46, claims 53-56 depend from claim 52, and claims 58-64 depend from claim 57. Applicants respectfully submit that these claims are nonobvious, because if an independent claim is nonobvious, any claim depending from the independent claims is also nonobvious. MPEP §2143.03.

Claims 35-39

Claims 35-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,761,485 issued to Munyan (*Munyan*) in view of U.S. Patent No. 5,761,485 issued to Kikinis (*Kikinis*) and *Fernandez*. Applicants respectfully submit that the cited reference fails to anticipate the claimed invention for at least the following reasons.

Claim 35 recites the following:

a server device to store digital content and to provide the digital content to other devices on the network;
a data retrieval device coupled with the server device; and
a playback device to store and to playback the digital content coupled with the data retrieval device, the playback device to store **a most-recent episode of a dynamically changing series of digital content**, and to have the digital content automatically updated from the server device with a subsequent episode of the series of digital content to store on the playback device.

The Office Action at page 7 cites *Munyan* as disclosing a server device and a playback device.

The Office Action further cites U.S. Patent No. 5,918,013 issued to Mighdoll et al. (*Mighdoll*) as disclosing coupling the playback device to the server device, and automatically updating the content. The Office Action lastly cites *Fernandez* as disclosing "automatically updating the playback device to replace content consumed." Assuming for the sake of argument in this Response that the Office Action correctly interprets these references, which Applicants do not

concede, the cited references and accompanying discussion in the Office Action fail to disclose or suggest every limitation of the invention as recited in claim 35. Applicants contend that the discussion at col. 7, lines 49 to 62 of automatically loading pages of a CD book (see col. 7, lines 24 to 35) of *Fernandez* fails to disclose or suggest storing a most-recent episode of a dynamically changing series of digital content. *Fernandez* suggests that the pages to be loaded are subsequent pages of the same material, or fixed digital content (see col. 7, lines 30 to 35). *Fernandez* fails to disclose or suggest that any content is dynamic, and fails to disclose or suggest that any content is a most-recent episode of a dynamically changing series, as recited in the claim. Thus, *Fernandez* fails to disclose or suggest at least this element of the claimed invention, and so fails to provide support for the obviousness rejection of claim 35.

Therefore, Applicants respectfully submit that claim 35 is nonobvious over the cited references. Furthermore, MPEP § 2143.03 sets forth that if an independent claim is nonobvious, a claim depending from the independent claim is also nonobvious. Therefore, claims 36-39, which depend from claim 35, are also nonobvious over the cited references.

Conclusion

For at least the foregoing reasons, Applicant submits that all rejections have been overcome. Therefore, Applicant submits that all pending claims are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number
02-2666.

Respectfully submitted,
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